

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application in view of the amendments and the remarks to follow. New claims 29-34 are added. Claims 1-34 are pending in this application.

New claims 29-34 are supported at least by text appearing at p. 5, line 23 through p. 33, line 21 of the application as originally filed. No new matter is added by new claims 29-34. New claims 29-34 distinguish over the art of record and are allowable.

35 U.S.C. § 101

Claims 10-12 and 25-28 are stated in the Office Action (p. 2) to stand rejected under 35 U.S.C. §101. Applicant respectfully traverses and requests reconsideration.

The Office Action states (p. 2) that these claims are directed to non functional descriptive data stored on a medium. The Examiner provides no basis in statutory law, PTO rules or case law, or in 37 CFR or the MPEP, for the opinion that Applicant's claims should be so characterized or that such has any relationship whatsoever to determining how the requirements of 35 U.S.C. §101 regarding what is or is not statutory subject matter apply to the claimed subject matter. Simply stating an unsupported conclusion and ignoring the recitations in Applicant's claims that relate to useful, concrete and tangible results does not comprise an appropriate basis for rejection, as is described below in more detail.

First, Title 35, Sec. 101, entitled "Inventions patentable", states that: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title". Claims 10-12 and 24-27 are directed to "One or more computer-readable media", while claim 28 is directed to "An apparatus comprising: a storage device to store a data structure; and an annotation module" As such, such statute explicitly provides for a machine or a manufactured element as a statutory category of subject matter for which Applicant is entitled to apply for a patent, and claims 10-12 and 24-28 clearly fall within the ambit of the statute as comprising statutory subject matter.

Second, Applicant notes the requirements of MPEP §706.03, entitled "Rejections Not Based on Prior Art". This MPEP section states that:

The primary object of the examination of an application is to determine whether or not the claims are patentable over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to nonprior art or "technical" rejections. Effort in examining should be concentrated on truly essential matters, minimizing or eliminating effort on technical rejections which are not really critical. Where a major technical rejection is proper (e.g., lack of proper disclosure, undue breadth, utility, etc.) such rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression.

The commentary supplied in the Office Action fails to provide a full development of reasons for the rejection. Further, MPEP §707.07, entitled "Completeness and Clarity of Examiner's Action", states that "The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made." Accordingly, the Examiner has not met the burden for presenting a complete and full development of reasons in making the rejection.

Third, the Office Action states a conclusion that the claims do not comport with the requirements of 35 U.S.C. §101 but provides no legal authority for such a conclusion. Authority for such a conclusion may flow from the Constitution, from Title 35, United States Code or from any of several interpretations of 35 U.S.C., such as the Code of Federal Regulations, Title 37, or the Manual of Patent Examination Procedure.

Fourth, turning now to the latter, numerous guidelines in the appropriate application of 35 U.S.C. §101 are provided. These guidelines are intended to

promote uniformity in positions expressed by employees of the Patent Office in the context of patent examination. With respect to rejections based on 35 U.S.C. §101, Applicant notes with particularity MPEP §706.03(a), entitled "Rejections under 35 U.S.C. 101". This MPEP section provides numerous grounds for such rejection. However, this MPEP section does not discuss rejections under 35 U.S.C. §101 based on subject matter comprising exclusively steps. Put another way, the MPEP sets forth clear guidelines for application of the patent statutes in patent examination, none of which are directed to recitations of steps.

Fifth, further guidance in application of 35 U.S.C. §101 is found in MPEP §2106, entitled "Patentable Subject Matter - Computer-Related Inventions" (see also MPEP §2107.01, entitled "General Principles Governing Utility Rejections"). MPEP §2106 states, inter alia, in subsection I, entitled "INTRODUCTION", that "These Examination Guidelines for Computer-Related Inventions ("Guidelines") are to assist Office personnel in the examination of applications drawn to computer-related inventions. "Computer-related inventions" include inventions implemented in a computer and inventions employing computer-readable media." As such, this MPEP section explicitly provides for subject matter such as is recited in these claims.

This MPEP section also states that "Thus, it is improper to read into section 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations." The Examiner has identified no guidance whatsoever, other than the Examiner's personal opinions, that would suggest that Congress intended for 35 U.S.C. §101

to be interpreted as is espoused in the Office Actions. The rejection under 35 U.S.C. §101 clearly falls outside the scope of the statute as described in the MPEP.

This MPEP section also provides guidelines for examination. In a subsection II(A), entitled "Identify and Understand Any Practical Application Asserted for the Invention", this MPEP section states that: "The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful."

Applicant finds the language "the second data field identifies a plurality of different versions of the multimedia content to which the annotation corresponds" to appear in claim 10. Applicant finds the language "a second data field, correlated through the data structure to the first data field, configured to cause a processor to correlate the second data field with a plurality of different versions of the multimedia content to which the annotation corresponds" to appear in claim 25. The functionality of the second data field is to associate the first data field containing the annotation with the plurality of different versions of the multimedia content to which the annotation corresponds. Applicant finds the language

"wherein the apparatus is configured to: receive a user request to create a new annotation; and correlate the new annotation with different versions of the same multimedia content via the data structure, wherein the different versions of the same multimedia content is part of a plurality of media streams" to appear in claim 28, along with recitation of affirmative elements of an apparatus and their interrelationship.

Furthermore, apparatus for implementation of the claimed subject matter is described in the specification at least at p. 11, line 20 through p. 16, line 18 with reference at least to Figs. 1 through 4; an annotation storage structure and functionality thereof is described in the specification at least at p. 16, line 20 through p. 23, line 5 with reference at least to Figs. 5 and 6; a user interface useful with the apparatus is described at least at p. 23, line 8 through p. 24, line 0 with reference at least to Fig. 7; annotation creation is described at least at p. 24, line 12 through p. 31, line 2 with reference at least to Figs. 8 and 9; and annotation and media segment presentation is described at least at p. 31, line 5 through p. 33, line 13 with reference at least to Figs. 10 and 11. Such disclosure clearly sets forth indication of practical application for the claimed subject matter.

In a subsection IV, entitled "DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. 101", this MPEP section states that the Examiner should "Consider the Breadth of 35 U.S.C. 101 Under Controlling Law". The Examiner has provided no basis in law for the rejection nor for the reasoning behind the rejection.

This subsection further notes that "As the Supreme Court has held, Congress chose the expansive language of 35 U.S.C. 101 so as to include

"anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980)."

This MPEP subsection further notes that "In *Chakrabarty*, 447 U.S. at 308-309, 206 USPQ at 197, the court stated:

In choosing such expansive terms as "manufacture" and "composition of matter," modified by the comprehensive "any," Congress plainly contemplated that the patent laws would be given wide scope. The relevant legislative history also supports a broad construction. The Patent Act of 1793, authored by Thomas Jefferson, defined statutory subject matter as "any new and useful art, machine, manufacture, or composition of matter, or any new or useful improvement [thereof]." Act of Feb. 21, 1793, ch. 11, § 1, 1 Stat. 318. The Act embodied Jefferson's philosophy that "ingenuity should receive a liberal encouragement." V Writings of Thomas Jefferson, at 75-76. See *Graham v. John Deere Co.*, 383 U.S. 1, 7-10 (148 USPQ 459, 462-464) (1966). Subsequent patent statutes in 1836, 1870, and 1874 employed this same broad language. In 1952, when the patent laws were recodified, Congress replaced the word "art" with "process," but otherwise left Jefferson's language intact. The Committee Reports accompanying the 1952 Act inform us that Congress intended statutory subject matter to "include anything under the sun that is made by man." S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952). [Footnote omitted]

This perspective has been embraced by the Federal Circuit:

The plain and unambiguous meaning of section 101 is that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in Title 35, such as those found in sections 102, 103, and 112. The use of the expansive term "any" in section 101 represents Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101 and the other parts of Title 35. . . . Thus, it is improper to read into section 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations.

Alappat, 33 F.3d at 1542, 31 USPQ2d at 1556.

This MPEP section also states that "Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection." Accordingly, in the event that the rejection is maintained, Applicant again requests clarification of the rejection.

Sixth, the patent statutes at 35 U.S.C. §112 require the Applicant to present claims in the manner which it regards as its invention. Accordingly, the Examiner must examine the claims in the manner in which the Applicant "regards" its invention. How Applicant regards its invention is accordance with the literal wording of the claims. Further, 35 U.S.C. §103(a) states that the subject matter of the claimed invention is to be considered "as a whole". The interpretation the Examiner has placed on Applicant's claims is clearly at odds with the meaning of the term as used in claim 28.

Seventh, and further, the strained interpretation provided by the Examiner gives the term "apparatus" a meaning repugnant to the ordinary meaning of the term. This is discussed in more detail in MPEP §2111.01, entitled "Plain Meaning". This MPEP section states that "THE WORDS OF A CLAIM MUST BE GIVEN THEIR "PLAIN MEANING" UNLESS THEY ARE DEFINED IN THE SPECIFICATION". This MPEP section further states that "While the meaning of claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has

provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)".

The interpretation relied on by the Examiner clearly gives the term "apparatus" a meaning repugnant to the ordinary meaning of the term. Such is explained below in more detail.

A dictionary definition of the term "apparatus", taken from Merriam-Webster's Collegiate Dictionary, Tenth Ed. (copyright 1996, Merriam-Webster, Inc., Springfield MA, pp. 55-56) is provided to clarify the meaning of that term in the English language. That definition is: "a set of materials or equipment designed for a particular use" or "an instrument or appliance designed for a specific operation".

MPEP §608.01(o), entitled "Basis for Claim Terminology in Description", explains that it is improper to give a term a meaning repugnant to the ordinary meaning of the term in claim interpretation. This MPEP section states that:

The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term.

The meaning the Examiner is giving to the term "apparatus" is clearly repugnant to the ordinary meaning of the term. As such, the rejection of claims is in error and contravenes appropriate standards for examination.

Eighth, further guidance in application of 35 U.S.C. §101 is provided in MPEP § 2111.01. In subsection II(A), this MPEP section puts forth guidelines for appropriate application of 35 U.S.C. 101, stating that:

A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459. Office personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971). Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.

Again, Applicant finds the language "the second data field identifies a plurality of different versions of the multimedia content to which the annotation corresponds" to appear in claim 10. Applicant finds the language "a second data field, correlated through the data structure to the first data field, configured to cause a processor to correlate the second data field with a plurality of different versions of the multimedia content to which the annotation corresponds" to appear in claim 25. The functionality of the second data field is to associate the first data field containing the annotation with the plurality of different versions of the multimedia content to which the annotation corresponds.

Applicant finds the language "wherein the apparatus is configured to: receive a user request to create a new annotation; and correlate the new annotation with different versions of the same multimedia content via the data structure, wherein the different versions of the same multimedia content is part of a plurality of media streams" to appear in claim 28, along with recitation of affirmative

elements of an apparatus and their interrelationship. Independent claims 10, 24 and 28 and claims dependent therefrom thus include practical application in the technological arts.

Further, the Examiner has clearly failed to meet the burden set forth above to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result.

Ninth, Applicant is entitled to employ functional description in describing claimed subject matter. Guidance in appropriate interpretation of such is provided in the MPEP at §2173.05(g), entitled "Functional Limitations". This MPEP section states that: "A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971)."

This MPEP section further states that: "A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step."

As such, the interpretation of 35 U.S.C. §101 provided in the Office Action is without discernible legal support, improperly characterizes the claimed subject

matter, does not comport with PTO regulations and is at odds with long-standing guidelines for claim examination. Additionally, the interpretation of the statute is not in conformance with the guidelines put forth by the Patent Office for examination of applications.

Tenth, Applicant notes that claim 21 of deVries, applied by the Examiner as discussed below with reference to rejections under 35 U.S.C. §103(a), recites:

An article of manufacture for annotating media, the article of manufacture comprising:

a computer readable storage medium; and

computer programming stored on the storage medium; wherein the stored computer programming is configured to be readable from the computer readable storage medium by one or more computers and thereby cause the one or more computers to operate so as to:

identify one or more particular times within a period defined by a start time and an end time of a media stream at which content within the media stream corresponds to an annotation value;

associate the annotation value with the identified one or more particular times; and

identify a probability representing a measure of confidence in an accuracy of the annotation value corresponding to the identified one or more particular times.

How does the Examiner distinguish between such recitation and that of Applicant's claims? How does the Examiner propose to articulate such distinction in accordance with the obligations noted above?

Eleventh, Applicant further notes that the Examiner has not responded adequately or in full to the legal arguments presented in the Response dated July 1, 2003, or those contained in the Response to Arguments tendered in the Office Action dated March 31, 2003. Applicant notes the requirements of MPEP §707.07(f), entitled "Answer All Material Traversed". This MPEP section states that "Where the applicant traverses any rejection, the examiner should, if he or she

repeats the rejection, take note of the applicant's argument and answer the substance of it."

The Examiner has failed to provide any indication on the record that the Examiner even read the arguments put forth by the Applicant. Applicant has provided the Examiner with a revised Amendment with each argument specifically and separately enumerated in order to assist the Examiner in locating and identifying each argument and thus to facilitate meeting the obligations set forth clearly in the MPEP. Thus, for at least these eleven enumerated reasons, Applicant respectfully submits that claims 10-12 and 25-28 comply with 35 U.S.C. §101. Accordingly, Applicant respectfully requests that the §101 rejections be withdrawn.

35 U.S.C. § 103

Claims 1-12, 20, 22, 23 and 25-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over "Synchronized Multimedia Integration Language (SMIL) 1.0 Specification", W3C Recommendation 15 June 1998, (hereinafter "W3C") in view of U.S. Patent No. 6,332,144 to deVries et al. (hereinafter "deVries").

To clarify the record, Applicant respectfully notes that claims 13-24 and 28 stand newly rejected on grounds not previously presented and/or stand rejected with respect to newly-cited reference material. Applicant respectfully submits that claims 1-28 are not unpatentable over W3C in view of deVries, Logan and/or Wei and requests reconsideration.

In traversing the rejections, it is helpful to first review the teachings of the references. Accordingly, brief summaries of W3C, deVries, Logan and Wei appear below.

W3C provides a specification for a "Synchronized Multimedia Integration Language" (Title). This language is intended to allow integration of "a set of independent multimedia objects into a synchronized multimedia presentation. Using SMIL, an author can

1. describe the temporal behavior of the presentation
2. describe the layout of the presentation on a screen
3. associate hyperlinks with media objects" (Abstract).

deVries describes a "Technique For Annotating Media" (Title), and teaches that "To annotate media, one or more particular times within a period defined by a start time and an end time of a media stream forming an item of audio or video

media, are identified. The identified times are those at which content within the media stream corresponds to an annotation value. The annotation value is associated with the identified times to annotate the media." (Abstract).

Logan is directed to an "Audio Message Exchange System" (Title). Logan teaches "An audio program and message distribution system in which a host system organizes and transmits program segments to client subscriber locations. The host organizes the program segments by subject matter and creates scheduled programming in accordance with preferences associated with each subscriber. Program segments are associated with descriptive subject matter segments, and the subject matter segments may be used to generate both text and audio cataloging presentations to enable the user to more easily identify and select desirable programming. A playback unit at the subscriber location reproduces the program segments received from the host and includes mechanisms for interactively navigating among the program segments. A usage log is compiled to record the subscriber's use of the provided program materials, to return data to the host for billing, to adaptively modify the subscriber's preferences based on actual usage, and to send subscriber-generated comments and requests to the host for processing. Voice input and control mechanisms included in the player allow the user to perform hands-free navigation of the program materials and to dictate comments and messages which are returned to the host for retransmission to other subscribers." (Abstract).

Wei teaches "A Distributed Media Authoring System For Networked Scholarly Workspaces" (Title). Wei teaches that this provides "a software framework for composing distributed media in the context of university research

and instruction. Authors may compose networked media, software tools and mediastreams, and can freely annotate media by media of any form using schema of their own design. Faculty and student authors compose distributed media using common Macintosh, World Wide Web and NeXTSTEP applications, supported by services from UNIX workstations." (Abstract).

The Office Action states (p. 3) that "W3C discloses a system (p.26, ex. 4) for associating annotations, contained in the <text.../> tag, to the plurality of media streams, representing different versions of multimedia content ... as explained in the header of the example." The Office Action also states (p. 8) that "Applicant argues that the text tag does not qualify as annotations. The Office disagrees. The text is contained with a <par> tag (§ 4.2.1), with the <switch> block."

The Office Action further states (id.) that "The ellipses at 6, 9, and 12, are clearly meant to be the alternative parts. These are the different version [sic] of multimedia content." Applicant disagrees and requests reconsideration.

In this example, <text .../> represents the multimedia content and is not an annotation (see, e.g., the Title of this section - "Choosing between content written for different screens"). Note that no other element is provided that could represent any other media content in this example. Note also that in the immediately preceding example, "<audio .../>" is the syntax, with "..." representing a specific audio source, such as: src="joe-audio-french" system-language ="fr". Ellipsis simply indicates that the argument pointing to the text source is arbitrary in this example.

The Office Action also states (p. 3) that "W3C does however disclose that both the annotations and media are referenced by a URI (p. 19, "src")...." The

Office Action also states (p. 5) that W3C teaches "a data field representing an annotation" Applicant respectfully disagrees. W3C is silent with respect to annotations, and the Examiner has admitted this on the record (p. 3; see also p. 7, Office Action dated June 18, 2003).

W3C provides fixed, predetermined fields corresponding to a specific source or data type having no relationship to critical commentary regarding content. Such is not an annotation as described in Applicant's specification or as the term is used in the English language.

Applicant notes the requirements of MPEP §2111.01, entitled "Plain Meaning", previously presented hereinabove (see supra). The interpretation relied on by the Examiner clearly gives the term "annotation" a meaning repugnant to the ordinary meaning of the term.

A dictionary definition of "annotation" is provided to attempt to clarify such, taken from p. 47 of Merriam-Webster's Collegiate Dictionary, Tenth Ed. (copyright 1996, Merriam-Webster, Inc., Springfield MA). This definition is: "n 1: a note added by way of comment or explanation 2: the act of annotating". This dictionary defines "annotate" to mean "vi: to make or furnish critical or explanatory notes or comment ~ vt : to make or furnish annotations for (as a literary work or subject)". In other words, "ANNOTATE" implies furnishing critical, historical or explanatory notes.

Applicant's specification provides examples of annotation at least at p. 2, line 19 et seq. (additional discussion and examples of annotation are provided in the detailed description), stating that:

Multimedia presentations may also include "annotations" relating to the multimedia presentation. An annotation is data (e.g., audio, text,

video, etc.) that corresponds to a multimedia presentation. Annotations can be added by anyone with appropriate access rights to the annotation system (e.g., the lecturer/trainer or any of the students/trainees). These annotations typically correspond to a particular temporal location in the multimedia presentation and can provide a replacement for much of the "in-person" interaction and "classroom discussion" that is lost when the presentation is not made "in-person" or "live". As part of an annotation, a student can comment on a particular point, to which another student (or lecturer, assistant, etc.) can respond in a subsequent annotation. This process can continue, allowing a "classroom discussion" to occur via these annotations. Additionally, some systems allow a user to select a particular one of these annotations and begin playback of the presentation starting at approximately the point in the presentation to which the annotation corresponds.

W3C states (p. 17, §4.2.3, entitled "Media Object Elements") that "ref, animation, audio, img, video text and textstream" are media object elements. W3C further indicates that such media object elements may have attributes such as duration. Such is completely inconsistent with the characterization of such objects as annotations provided in the Office Action. This and previous Office Actions fail to identify any teaching whatsoever of annotation anywhere in W3C. As such, W3C provides no disclosure, teaching, suggestion or motivation for any "annotation".

The Office Action further states (p. 3) that "W3C does however disclose that both the annotations and media are referenced by a URI (p. 19, "src")" Such is in error for several reasons.

First, as noted above, W3C is silent with respect to any annotation.

Second, combining the teachings of W3C with those of deVries fails to provide "an annotation database, coupled to the multimedia server, that stores a plurality of annotations, wherein each of the plurality of annotations is correlated with different versions of multimedia content contained in the plurality of media

streams", as recited in claim 1, any "storage device to store a data structure; and an annotation module to store an annotation in the storage device so that the annotation is correlated with different versions of the same multimedia content via the data structure", as recited in claim 7, any "second data field identifies a plurality of different versions of the multimedia content to which the annotation corresponds", as recited in claim 10, any "method comprising: receiving an indication of a version of media content being presented to a user; identifying a collection of annotations corresponding to the media content, each annotation corresponding to a plurality of different versions of the media content; and providing selected annotations from the collection of annotations to the client computer for presentation to the user", as recited in claim 20, any "second data field, correlated through the data structure to the first data field, configured to cause a processor to correlate the second data field with a plurality of different versions of the multimedia content to which the annotation corresponds", as recited in claim 25 or any "receive a user request to create a new annotation; and correlate the new annotation with different versions of the same multimedia content via the data structure, wherein the different versions of the same multimedia content is part of a plurality of media streams", as recited in claim 28.

In contrast, deVries teaches (col. 2, lines 10-13) that "According to the present invention, an item of audio or video media is annotated by identifying the particular time or times within the period defined by the start and end times of a media stream forming an item of media." There is no teaching, disclosure, suggestion or motivation in either W3C or deVries of any annotation being associated with multiple versions of multimedia content.

Accordingly, combining the teachings of the references does not provide the invention as recited in any of independent claims 1, 7, 10, 20, 25 or 28 or any claims dependent therefrom. Additionally, there is no teaching or disclosure within the references to guide one of ordinary skill in selecting elements from the references or combining the selected elements.

Claim 13 recites "A method comprising: receiving a user request to create a new annotation; and associating the new annotation with a set of media streams, wherein the set of media streams is part of a plurality of media streams, and wherein each of the plurality of media streams is a different version of multimedia content", which is not taught, disclosed, suggested or motivated by the cited references.

As noted above, W3C is silent with respect to annotations. The word "annotation" does not appear anywhere in W3C. Modifying the teachings of W3C fails to provide the invention as recited in claim 13 and specifically fails to provide "associating the new annotation with a set of media streams", as recited in claim 13. Logan addresses audio message exchange and does not teach multimedia streams or different versions of such. As a result, the proposed combination fails to provide the subject matter recited in claim 13.

None of the references provides any teaching, disclosure, suggestion or motivation that would lead one to any "computer-readable memory containing a computer program that is executable by a computer to perform the method of claim 13", as recited in claim 19, and the Office Action fails to provide any clue as to where related subject matter might be found. The argument (p. 6) that **"Regarding dependent claim 19, the computer programs for executing the**

methods of claims 13 [sic] are rejected under the same rationale" (a similar argument is presented with respect to the subject matter of claim 23 at page 5) appears to reflect the earlier-provided "it would have been obvious" argument. Such fails to establish any correspondence between the teachings of the references and the recitations of the claim. Clarification, and a meaningful legal analysis, are requested.

All of the unpatentability rejections fail to meet the standards set forth in the MPEP for establishing a prima facie case of unpatentability. These are set forth in MPEP §2142, entitled "Legal Concept of Prima Facie Obviousness" (see also MPEP §706.02(j)).

This MPEP section states that "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." The references fail to teach or disclose the elements recited in the claims. Accordingly, the references cannot provide motivation to modify their teachings to arrive at the invention as claimed, and the Examiner has identified no such teaching or disclosure in the references. As a result, the first prong of the test cannot be met.

MPEP §2143 further states that "Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Inasmuch as the references fail to provide all of the features recited in Applicant's claims, the third prong of the test is not met. As a result, there cannot

be a reasonable expectation of success. As such, the second prong of the test cannot be met.

MPEP §2143 additionally states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." This fourth criterion cannot be met because the references fail to teach or disclose the elements recited in the claim.

Accordingly, the unpatentability rejections fail all of the criteria for establishing a prima facie case of obviousness as set forth in the MPEP.

Inasmuch as there is no guidance within the references, and as there is no basis for the Examiner's contentions within the cited references, the only possible motivation for these contentions is hindsight reconstruction wherein the Examiner is utilizing Applicant's own disclosure to construct a reason for combining the cited references. The Examiner is reminded that hindsight reconstruction is not an appropriate basis for a §103 rejection. (*See, e.g., Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explaining that hindsight reconstruction is an improper basis for rejection of a claim).).

The impropriety of "obvious to try" as a standard for unpatentability is described in more detail below with reference to MPEP §2145(X)(B). This MPEP section states that:

The admonition that 'obvious to try' is not the standard under §103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either

no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.... In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (citations omitted).

No indication as to which parameters are critical and no direction as to which of many possible choices is likely to be successful has been identified in the references relied upon.

Further, Applicant notes that no evidence has been provided as to why it would be obvious to combine or modify the teachings of these references. Evidence of a suggestion to combine or modify may flow from the prior art references themselves, from the knowledge of one skilled in the art, or from the nature of the problem to be solved. However, this range of sources does not diminish the requirement for actual evidence. Further, the showing must be clear and particular. See *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999).

To recapitulate the several legal arguments relative to alleged unpatentability: the Office Action mischaracterizes the record; (ii) the references do not provide the elements recited in the claims; (iii) the Office Action (a) mischaracterizes the teachings of the references, (b) improperly gives the terminology of the claims and/or references meaning repugnant to the ordinary meaning of the terms and (c) improperly gives this terminology meaning inapposite to the disclosure of the application; (iiiv) the rejections fail to meet the criteria for a prima facie showing of unpatentability set forth in the MPEP; (v) the rejections are based on impermissible hindsight; (vi) the rejections employ an

improper "obvious to try" standard; and (vii) no proper evidence of suggestion to modify or combine has been provided.

Dependent claims 2-6, 8, 9, 11, 12, 14-19, 21-24 and 26-27 are allowable as depending from an allowable base claim and for their own recited features which are neither shown nor suggested by the prior art. For at least these reasons, Applicant respectfully requests that the §103 rejections of claims 1-28 be withdrawn, and that claims 1-28 be allowed.

Deficiencies in Examination

The Examiner's response to argument is deficient in multiple regards. A first deficiency is that the response to argument clearly fails to respond to Applicant's arguments with respect to the rejections under 35 U.S.C. §103, or, in the alternative, is an admission that these rejections are defective.

Applicant notes the requirements of MPEP §707.07, entitled "Completeness and Clarity of Examiner's Action". This MPEP section cites 37 CFR §1.104, entitled "Nature of examination" which in turn states, in subsection (b), entitled "Completeness of examiner's action" that "The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made."

This MPEP section further states, under a heading labeled "Examiner Note" that "The Examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied." The Office Action clearly fails to comport with these requirements as set forth in the MPEP, at least because the Office Action both fails to address Applicant's arguments with respect to anticipation and continues to reject claims as being anticipated. Applicants have enumerated the various grounds of argument in this Response in order to facilitate meaningful rebuttal.

A second deficiency is that the combinations used in the unpatentability rejections fail to provide all of the features recited in any of Applicant's independent claims. The Examiner has ignored these features without providing any appropriate legal basis for doing so.

A third deficiency is the failure to respond to all arguments traversing the unpatentability rejections. Merely repeating that "it would be obvious" to provide the features recited in the claims does not constitute a basis for rejection of the claims, particularly when the references fail to provide the features recited in the claims and the rejections fail to meet the standards for such rejections as set forth in the MPEP and as demonstrated by Applicant.

A fourth deficiency is to combine the teachings of disparate references absent any guidance in the references to support the combination when main intentions of each of the cited references are defeated by the combination and the Examiner has completely failed to respond to Applicant's repeated legal arguments showing this to be the case.


For at least these reasons, the Office Action fails to comport with appropriate standards for examination. The Examiner should either allow Applicant's claims or provide a meaningful basis for rejection and an appropriate response to Applicant's arguments.

Conclusion

Claims 1-34 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

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